

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 1-2, 5-10, 12-13, 15-16 and 84-108 are pending after entry of the amendments set forth herein.

Claims 3-4, 11, 14, 17-83 and 109-112 have been canceled without prejudice to the possibility of filing one or more continuing applications directed to the subject matter recited therein.

Claims 1-2, 5-10, 12-13, 15-16 and 84-108 were examined. Claims 1-2, 5-10, 12-13, 15-16 and 84-108 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected On Ground of Non-Statutory Double Patenting (U.S. Patent No. 6,685,632)

In the Official Action of October 9, 2007, claims 1-2, 5-10, 12-13, 15-16 and 101-108 were rejected on the ground of nonstatutory double patenting over claims 1-2, 5-10, 12-13 and 15-16 of U.S. Patent No. 6,685,632. The Examiner asserted that the claims if allowed would improperly extend the right to exclude already granted in the patent. The Examiner asserted that the claims in the patent are in effect a species of the generic invention recited in the present claims. Applicants respectfully traverse.

Claims 1 and 101 have been amended above to recite that locking of both articulating joints (claim 1) or the grip member and at least one joint member (claim 101) is carried out by actuation of a single actuator. Support for these amendments can be found, for example, at page 28, lines 21-35 of the specification and throughout the specification. It is respectfully submitted that this is more restrictive than what is claimed in U.S. Patent No. 6,685,632 and therefore the claims of the patent are not in effect a species of a genus recited by the present claims.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-2, 5-10, 12-13, 15-16 and 101-108 on the ground of

nonstatutory double patenting over claims 1-2, 5-10, 12-13 and 15-16 of U.S. Patent No. 6,685,632, as being inappropriate.

Claims Rejected On Ground of Nonstatutory Obviousness-Type Double Patenting (U.S. Patent No. 6,685,632 in view of Hancock)

Claims 84-100 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock, U.S. Patent No. 6,331,157. The Examiner asserted that the patented claims do not include a retractor with a drive mechanism and first and second retractor blades wherein the instrument is mountable to at least one of the blades. However, the Examiner asserted that it would have been obvious to provide the patented claims with the retractor shown by Hancock, in order to provide a stable support for the instrument mount and stabilizer. Applicants respectfully traverse.

Claim 84 has been amended above to recite a single actuator that is actuatable to lock and unlock two joints included in the instrument mount assembly. Support for this amendment can be found, for example, at page 28, lines 21-35 of the specification and throughout the specification. It is respectfully submitted that Hancock fails to teach such a single actuator as now claimed, and that neither claim 1 nor claim 5 of the 6,685,632 patent recites this. Accordingly, even if the combination suggested by the Examiner would have been obvious, which Applicants do not necessarily agree that it would have been, the resulting combination would still not meet all of the recitations of claims 84-100 as amended above, for at least the reasons provided above.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 84-100 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock, U.S. Patent No. 6,331,157, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 102(e) (Hancock)

Claims 1-2, 13, 15-16, 84-89 and 92-100 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Hancock, U.S. Patent No. 6,331,157. The Examiner asserted that Hancock shows an instrument mount apparatus 72 for positioning a surgical instrument comprising a mount body 92 having

a base portion 90 movably coupled at a first articulating joint (ball and socket joint) 112, and a side portion 94 movably coupled at a second articulating joint (ball and socket joint), and an actuator 122, 124, 154 operatively connected to the first and second articulating joints being freely movable when the actuator is in an unlocked position. The Examiner further asserted that the first and second articulating joints are compressed each into a substantially immovable condition when the actuator is placed in a locked position. Applicants respectfully traverse.

Claims 1 and 84 have been amended above to recite a single actuator that is actuatable to lock and unlock two joints included in the instrument mount assembly. Support for this amendment can be found, for example, at page 28, lines 21-35 of the specification and throughout the specification. It is respectfully submitted that Hancock fails to teach such a single actuator as now claimed. It is further respectfully submitted that reference number 154 in Hancock refers to a spring, see column 8, lines 49-50. Knob 124 is required to be turned to lock the turret 92/spherical joint 112, while rotation of knob 152 is required to lock joint 94. Accordingly, Hancock does not provide a single actuator as claimed.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-2, 13, 15-16, 84-89 and 92-100 under 35 U.S.C. Section 102(e) as being anticipated by Hancock, U.S. Patent No. 6,331,157, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 102(e) (Cartier et al.)

Claims 101-106 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854. The Examiner asserted that Cartier et al. shows an instrument mount apparatus for positioning a surgical instrument comprising a grip member 521 configured to lock and release from a stable support (retractor blade 4), at least one joint member (ball joint 54,56) for movably connecting the surgical instrument to the grip member; and a locking mechanism. The Examiner asserted that the locking mechanism is actuatable to both lock the grip member to the stable support and lock an orientation of the surgical instrument with respect to said grip member. The Examiner indicated that the surgical instrument is a stabilizer 30.

Applicants respectfully traverse. Claim 101 has been amended to further recite that the locking mechanism is actuatable via a single actuator to both lock said grip member to the stable support and lock an orientation of the surgical instrument with respect to the grip member. Support for this amendment can be found, for example, at page 28, lines 21-35 of the specification and throughout the specification. It is respectfully submitted that Cartier et al. fails to teach such a single actuator as now

claimed. It is further respectfully submitted that the locking mechanism for locking the orientation of the stabilizer 30 of Cartier et al. requires actuation of at least two independent actuators for locking the joint that ball 54,56 is included in and for locking the joint 80 (Fig. 1A), respectively.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 101-106 under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Cartier et al. in view of Benetti et al.)

Claims 107-108 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Benetti et al., U.S. Patent Application Publication No. 2001/0044572. The Examiner admitted that the stabilizer of Cartier et al. does not comprise a plurality of interconnecting links articulating with the joint member and the stabilizer, but asserted that it would have been obvious to replace the rod of Cartier et al. with the flexible system of Benetti et al. to enable the surgeon to place the stabilizer in many more orientations.

Applicants respectfully traverse. Claims 107-108 depend from claim 101, and, it is respectfully submitted, are therefore allowable for at least the same reasons provided above with regard to claim 101, since Benetti et al. does nothing to make up for the deficiencies of Cartier et al. in meeting the recitations of claims 101.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 107-108 under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Benetti et al., U.S. Patent Application Publication No. 2001/0044572, as being inappropriate.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-011CON2.

Respectfully submitted,
LAW OFFICE OF ALAN W. CANNON

Date: _____

1/9/08

By: _____



Alan W. Cannon

Registration No. 34,977

LAW OFFICE OF ALAN W. CANNON
942 Mesa Oak Court
Sunnyvale, CA 94086
Telephone: (408) 736-3554
Facsimile: (408) 736-3564